

Therefore, attached are replacement copies of the missing references, together with a clean copy of the PTO-1449 form listing the corresponding references. Consideration of the replacement copies is respectfully requested.

2. Rejection of Claims 8, 9, 15-21, 22-25, 27-29, 31, 35, 36, 49-52, and 54-59 Under 35 USC §102(b) in view of U.S. Patent No. 4,629,647 (Sander)

① This rejection is respectfully traversed on the grounds that the Sander patent fails to disclose or suggest alteration of a hologram by modifying a contour of the diffraction structures, as originally recited in claim 8, much less alteration of the hologram to individualize the appearance of the optically variable element that includes the diffraction structures, as presently recited in claim 8, or overlapping of a printed pattern by the optically variable element, also as presently recited in claim 8. Instead, Sander teaches filling in spaces *between* raised portions of the diffraction structures so that the optically variable element can be written on. The diffraction structures of Sander are not "altered," but rather are merely covered by a coat of lacquer.

The Examiner interprets element 4 of Sander as the diffraction structure. According to the Examiner, diffraction structures 4 are "altered" by element 9b shown in Fig. 2. This interpretation makes no sense. Elements 9b do not contact layer 4 (or 7), and are not replaced by elements 9b. Instead, elements 9b replace portions of layer 10a, which is the transparent signing layer. Elements 9b do not replace either layer 4 (which is a metal foil) or the layer 7, which is disclosed as the "diffraction structure" (col. 6, line 35 of Sander).

Claim 8 specifically recites modification of the contours of diffraction structures "presenting visually recognizable information," and in particular recites:

*... wherein the data carrier is provided with an alteration in a portion of the optically variable element, **the alteration comprising a modification of the contour of the diffraction structures,** ... (emphasis added).*

The Sander patent, which describes element 7 as "a diffraction structure having a holographic effect" (col. 6, line 35), also discloses diffraction structures having contours, but the contours of

Serial Number 10/982,194

the diffraction structures 7 are not altered by any of the other layers disclosed therein. Element 9b does not even remotely alter the contours of element 7, as claimed.

It may be argued that the diffraction structure 7 of Sander is "altered" by adding a layer of lacquer 3a. However, layer 3a merely covers structure 7, without altering it. Covering is not the same as altering. As explained in *Webster's Ninth New Collegiate Dictionary*, Merriam-Webster, Inc., 1995, "alter" means to "*to make different without changing into something else.*" Layer 7 of Sander is the same whether it is covered or not. In fact, the purpose of layer 3a is to enable formation of a writing surface, and not to alter the diffraction layer in any way, much less its contours.

The Examiner's interpretation of "altering" as reading on covering is not justified by the ordinary meaning of the word alter, or by the context of the invention. When snow falls on one's car in winter, it cannot be said that structure of the car is altered in any way by the snow. Similarly, merely coating a diffraction structure does not "alter" the structure. Instead, in order to serve as a hologram, it is essential in Sander that the diffraction structure not be altered by the addition of the writing surface. The diffraction structure has the same contour whether it is covered or not.

Although the Applicant believes that the Sander patent does not anticipate the original language of claim 8, claim 8 has nevertheless been amended to specify that the optically variable element at least partially overlaps a printed pattern. This feature, originally recited in claim 19, is clearly not anticipated by Sander (the issue of obviousness is discussed below).

In addition, claim 77 has been added to specify the type of alteration provided by the present invention, namely removal, change, or destruction of the contour of the diffraction structures. This feature is supported by lines 7-9 on page 39 of the specification as originally filed, and is clearly not anticipated by the lacquer coating of Sander.

Serial Number 10/982,194

Because Sander does not disclose all elements recited in the rejected claims, or in new claim 77, withdrawal of the rejection under 35 USC §102(b) is respectfully requested.

3. Rejection of Claims 26, 30, 32, and 53 Under 35 USC §103(a) in view of U.S. Patent No. 4,629,647 (Sander)

This rejection is also respectfully traversed on the grounds that the Sander patent fails to disclose or suggest alteration of the diffraction structure 7 (or 4) disclosed therein, much less alteration of contours of the structure to individualize the visually recognizable information, or overlapping of the diffraction structure and a printed pattern, as claimed.

It is noted that even when elements 9b are added to the structure of Sander, the information content of the hologram is not affected because, as explained in col. 8, lines 63-68 of Sander, *"In spite of the presence of the non-transparent lacquer 9b in the layer 8b, in the regions over the structure 7', the structure 7' can still be read, particularly if it is a hologram, even if with a poorer signal-noise ratio, as holograms afford the possibility of storing all the items of information in each and every region thereof."* The only way to affect the visually recognizable information is to actually alter the contours of the hologram, as claimed, rather than merely covering up portions of the hologram as disclosed in Sander.

Having thus overcome each of the rejections made in the Official Action, withdrawal of the rejections and expedited passage of the application to issue is requested.

Respectfully submitted,
BACON & THOMAS, PLLC



Date: December 17, 2002

By: BENJAMIN E. URCIA
Registration No. 33,805

BACON & THOMAS, PLLC
625 Slaters Lane, 4th Floor
Alexandria, Virginia 22314
Telephone: (703) 683-0500

NWB11:Document\AMEND5\02.ppt